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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,878	03/22/2002	Sunao Takatori	WAT P-16/500727.20023	4965

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REED SMITH, LLP  
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NEW YORK, NY 10022-7650

EXAMINER
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SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,878

Applicant(s)

TAKATORI ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12-12-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/02, 4/03, 10/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements filed on 10-29-03, 4-15-03 and 3-22-02 have been considered. The references that have been lined through have not been considered because an English translation was not submitted. Should the Applicant submit English translations of those documents at a later date, the Examiner will deem them timely and consider them for examination purposes.

### ***Claim Objections***

Claim 9 is objected to because of the following informalities: the phrase “when goods and/or service is purchased” is grammatically incorrect. The Examiner suggests amending the phrase to read, “when *said* goods and/or service *are* purchased.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 13 are indefinite because in the first paragraph it states “an identifier” then again in the second paragraph it states “an identifier.” Are the two identifiers the same or different? If they are the same, they should be preceded by the term “the” or “said.” If they are different they should be distinguished from one another so as to avoid further confusion.

Claim 13 is also indefinite because in the first paragraph it states “an account” and then in the second paragraph it states “a billing account.” Are the two accounts the same or different? If they are the same, they should be preceded by the term “the” or “said.” If they are different they should be distinguished from one another so as to avoid further confusion.

Claim 13 is also indefinite because it is unclear and confusing. It is not clear what is meant by the phrase “with reference to the identifier of the user and the plural pieces of billing account information in the storage means.” Clarification is required.

Claim 15 is indefinite because in the first paragraph it states “a billing account” and further in the in the same paragraph it states “a billing account.” Are the two billing accounts the same or different? If they are the same, they should be preceded by the term “the” or “said.” If they are different they should be distinguished from one another so as to avoid further confusion.

#### ***Claim Rejections - 35 USC § 101***

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 is directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has

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stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the Morrill, Jr. patent (US 5,991,749).

The Morrill reference discloses a charging system for charging a cost to an account opened by a user, comprising:

A portable device at least storing an identifier of the user and outputting billing account information of any billing account of a plurality of billing accounts (col. 2, lines 29-31), and

A control server including a storage means for storing the identifier of the user and plural pieces of billing account information corresponding to the identifier (col. 2, lines 29-31) and

a charging means for identifying the user by the identifier obtained from the portable device and for determining a billing account to be charged by the billing account information obtained from the portable device (col. 2, lines 18-31) (Claim 1);

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a terminal device receiving the identifier and the billing account information from the portable device and transmitting to the control server (col. 2, lines 60-67),

wherein the terminal device transmits a charging amount to the user together with the identifier and the billing account information to the control server (col. 2, lines 33-44), and

wherein the control server charges the charging amount to the determined billing account to be charged (col. 2, lines 45-59) (Claim 2);

the portable device is a portable terminal device having a portable device side storage means for storing the identifier of the user (col. 3, lines 46-63),

a display means for displaying a list of billing accounts based on the plural pieces of billing account information (col. 2, lines 32-44),

an input means for receiving operation of the user (col. 2, lines 32-44),

a selection means for selecting any of the plurality of billing accounts in response to the operation of the user to the input means (col. 2, lines 32-44), and

an output means for outputting billing information of the billing account selected by the selection means (col. 2, lines 32-44) (Claim 3);

the portable device side storage means of the portable device stores the plural pieces of billing account information of the plurality of billing accounts owned by the user (col. 2, line 45 through col. 3, line 5) (Claim 4);

the control server transmits the plural pieces of billing account information corresponding to the identifier of the user which are stored in the storing means to the portable device (col. 2, line 45 through col. 3, line 5), and

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the display means of the portable device displays the list of the billing accounts based on the plural pieces of billing account information which are transmitted from the control server (col. 2, lines 45 through col. 3, line 5) (Claim 5);

the portable device is a card storing the identifier of the user and billing account information of any billing account of the plurality of billing accounts, the billing account information being rewritable (col. 8, lines 49-63), and

the identifier of the user and the billing account information being readable (col. 8, lines 49-63) (Claim 6);

the portable device is a card storing the identifier of the user, the billing account information being rewritable and the identifier of the user being rewritable (col. 8, lines 49-63),

the control server transmits the plural pieces of billing account information corresponding to the identifier of the user which are stored in the storage means to the terminal device (col. 2, line 45 through col. 3, line 5), and

the terminal device displays the list of the billing accounts based on the plural pieces of billing account information which are transmitted from the control server, selects any of the plurality of billing accounts in response to operation of the user, and transmits the selected billing information to the control server (col. 2, line 45 through col. 3, line 5) (Claim 7);

the control server regard a predetermined billing account as a billing account to be charged when a billing account is not specified (col. 2, line 45 through col. 3, line 5) (Claim 8);

the portable device stores corresponding relation between a type of goods and/or service which the user purchases and any of the billing account information, when the goods and/or services are purchased, and a cost is incurred by the user, outputs billing account information

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which has corresponding relation with the goods and/or service (col. 2, line 45 through col. 3, line 5, and col. 4, lines 39-65) (Claim 9);

the portable device is a mobile telephone classifying and storing a plurality of destination telephone numbers (col. 2, lines 18-31), and

when a telephone call is made, outputting information of a group to which a destination telephone number of the telephone call belongs as the billing account information (col. 2, line 45 through col. 3, line 5),

the storage means of the control server stores a telephone number of the portable device as the identifier of the user as well as stores the plural pieces of billing account information corresponding to the user which relates to the groups to which the destination telephone numbers belong (col. 2, line 45 through col. 3, line 5), and

the charging means of the control service identifies the user from the telephone number of the portable device when the telephone call is made by the portable device (col. 2, line 45 through col. 3, line 5), and

determines a billing account to charge a charge for the telephone call, based on the billing account information corresponding to the group to which the telephone number of the calling destination belongs transmitted from the portable device (col. 2, line 45 through col. 3, line 5) (Claim 10);

the portable device is a portable terminal device having a portable device side storage means for storing the identifier of the user (col. 2, line 45 through col. 3, line 5),

a display means for displaying a list of the billing accounts based on the plural pieces of billing account information (col. 2, line 45 through col. 3, line 5),



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an input means for receiving operation of the user (col. 2, line 45 through col. 3, line 5),

a selection means for selecting any of the plurality of billing accounts in response to the operation of the user to the input means (col. 2, line 45 through col. 3, line 5), and

an output means for outputting billing account information of the billing account selected by the selection means (col. 2, line 45 through col. 3, line 5) (Claim 16);

the portable device side storage means of the portable device stores the plural pieces of billing account information of the plurality of billing accounts owned by the user (col. 2, line 45 through col. 3, line 5) (Claim 17);

the control server transmits the plural pieces of billing account information corresponding to the identifier of the user which are stored in the storing means to the portable device (col. 2, line 45 through col. 3, line 5), and

the display means of the portable device displays the list of the billing accounts based on the plural pieces of billing account information which are transmitted from the control server (col. 2, line 45 through col. 3, line 5) (Claim 18); and

the portable device is a card storing the identifier of the user and the billing account information of any billing account of the plurality of billing accounts, the billing account information being rewritable (col. 2, line 45 through col. 3, line 5), and

the identifier of the user and the billing account information being readable (col. 2, line 45 through col. 3, line 5) (Claim 19).

The Morrill reference discloses a charging method for charging a cost to an account opened by a user, comprising:

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A step where a portable device transmits an identifier of the user and billing account information of any billing account of a plurality of billing accounts (col. 2, line 45 through col. 3, line 5), and

A step of identifying the user by the identifier transmitted from the portable device based on an identifier which are stored in a customer database of a control server in advance (col. 2, line 45 through col. 3, line 5), and

Determining a billing account to be charged from among the plurality of billing accounts opened by the identified user by the billing account information transmitted from the portable device (col. 2, line 45 through col. 3, line 5) (Claim 11).

The Morrill reference discloses a portable device of a user opening an account to charge a cost, comprising:

A portable device side storage means for at least storing an identifier of the user (col. 2, lines 18-31), and

An output means for outputting billing account information of any billing account of a plurality of billing accounts opened by the user (col. 2, line 45 through col. 3, line 5) (Claim 12).

The Morrill reference discloses a control server comprising:

A storage means for storing an identifier of a user who opens an account to charge a cost and plural pieces of billing account information corresponding to the identifier (col. 2, line 45 through col. 3, line 5), and

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A charging means for identifying the user by an identifier of the user obtained from a portable device of the user, with reference to the identifier of the user and the plural pieces of billing account information in the storage means (col. 2, line 45 through col. 3, line 5), and

Determining a billing account to be charged by billing account information obtained from the portable device of the user (col. 2, line 45 through col. 3, line 5) (Claim 13).

The Morrill reference discloses a charging system for charging a cost to an account opened by a user, comprising:

A mobile telephone storing a plurality of destination telephone numbers and plural pieces of billing account information of a plurality of billing accounts opened by the user by relating each destination telephone number to any of the billing account information respectively (col. 2, line 45 through col. 3, line 5), and

When a telephone call is made, outputting billing account information related to a telephone number of the calling destination (col. 2, line 45 through col. 3, line 5), and

A control server determining a billing account to be charged by the billing account information obtained from the mobile telephone (col. 2, line 45 through col. 3, line 5) (Claim 14).

The Morrill reference discloses a charging system for charging a cost to an account opened by a user, comprising:

A mobile telephone classifying and storing a plurality of destination telephone numbers (col. 2, line 45 through col. 3, line 5),

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Relating a billing account opened by the user to each of a plurality of groups respectively (col. 2, line 45 through col. 3, line 5),

Storing plural pieces of billing account information of a plurality of billing accounts (col. 2, line 45 through col. 3, line 5), and

When a telephone call is made, outputting billing account information of a billing account related to a group to which a telephone number of the calling destination belongs (col. 2, line 45 through col. 3, line 5), and

A control server determining a billing account to be charged by the billing account information obtained from the mobile telephone (col. 2, line 45 through col. 3, line 5) (Claim 15).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Muftic, Hudson, Kravitz, Teicher, Davis, Walker, Armes and Lawlor patents are all directed to various types of electronic financial systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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